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EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/26/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary

Application No.

09/934,003

Applicant(s)

BAERLOCHER ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on January 15, 2003 in which applicant amends claims 1, 12, 30, and 49, amends the specification, and responds to the claim rejections.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 5, 12-14, 17-22, 30-37, 42-44, and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasquez, Jr. et al. (U.S. 4,695,053).

The rejection as stated in Office Action, Paper No. 4 is retained and incorporated herein.

4. Claims 1, 2, 4, 5, 12-16, 21, 30-36, 42-44, and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by any one of Price is Right's pricing games: Any Number, Cover Up, Dice Game, Easy as 1 2 3, Grand Game, Line'em Up, Side by Side, Squeeze Play, Switcheroo, Temptation, Ten Chances, Master Key, Money Game, One Away, Pathfinder, Pick a Number, or Lucky Seven.

The rejection as stated in Office Action, Paper No. 4 is retained and incorporated herein.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053) in view of Hamano (U.S. 5,205,555).

The rejection as stated in Office Action, Paper No. 4 is retained and incorporated herein.

7. Claims 6-11, 23-28, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053) in view of Take Your Pick.

The rejection as stated in Office Action, Paper No. 4 is retained and incorporated herein.

8. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053).

The rejection as stated in Office Action, Paper No. 4 is retained and incorporated herein.

Response to Arguments

9. Applicant's arguments filed January 15, 2003 have been fully considered but they are not persuasive.
10. The objection to Figures 3A and 3B is withdrawn because applicant amends the specification to overcome the deficiency.
11. Applicant traverses the rejection to claims 1, 4, 5, 12-14, 17-22, 30-37, 42-44, and 46-50 under 35 U.S.C. 102(b) as being anticipated by Vasquez, Jr. et al. (U.S. 4,695,053).
12. Applicant traverses the rejection to claims 1, 2, 4, 5, 12-16, 21, 30-36, 42-44, and 47-50 under 35 U.S.C. 102(b) as being anticipated by any one of Price is Right's pricing games: Any Number, Cover Up, Dice Game, Easy as 1 2 3, Grand Game, Line'em Up, Side by Side, Squeeze

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Play, Switcheroo, Temptation, Ten Chances, Master Key, Money Game, One Away, Pathfinder, Pick a Number, or Lucky Seven.

13. Applicant traverses the rejection to claims 3 and 29 under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053) in view of Hamano (U.S. 5,205,555).
14. Applicant traverses the rejection to claims 6-11, 23-28, and 38-41 under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053) in view of Take Your Pick.
15. Applicant traverses the rejection to claim 45 under 35 U.S.C. 103(a) as being unpatentable over Vasquez, Jr. et al. (U.S. 4,695,053).
16. Regarding claim 1, applicant alleges, "Vasquez does not disclose a processor which associates numbers with the positions or digits in display 36 based on the order of selection of the positions or digits by the player." The examiner respectfully disagrees. In Vasquez, in addition to winning in a base game wherein a random combination displayed on the reels corresponds to a predetermined winning combination, a player can also win based on a player selected winning combination. In Vasquez's preferred embodiment, players select numbers between 0 and 9 for each reel. The player then spins the reels. The player wins if any one of digits on reels 12, 14, or 16 corresponds to any one of the corresponding previously player selected digits. If two numbers match then the player is awarded more money. If three numbers match the winnings are greatly increased. For example, in Figure 1, if the player selects "3" for reel 1, "5" for reel 2, and "0" for reel 3, then although all three numbers selected by the player are displayed on the reels, the player only receives an award for the match appearing in reel 2. However, if the player was to select "0" for reel 1, "5" for reel 2, and "3" for reel 3, then the

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award is substantially improved. Therefore, the order in which a player selects digits in Vasquez is important to the outcome of the game.

17. Furthermore, regarding claim 1, applicant alleges, "Vasquez does not teach or suggest providing an award to a player which is based on the order of numbers associated with the positions. The examiner respectfully disagrees. Please see the argument provided above in item number 16.

18. Additionally, applicant alleges, "Vasquez does not disclose, teach, or suggest, providing an award that equals the value of the number indicated by digit indicators 34." However, regarding claim 1, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an award equals the value of the number indicated by digit indicators...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. Applicant alleges claims 2-11 are allowable because each claim depends upon claim 1. However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

20. Applicant alleges, "The Price is Right pricing games do not associate numbers with the positions in the prices based on the order of the selections of the positions by the player." The examiner disagrees. As indicated by applicant, The Price is Right pricing games generally disclose games in which players attempt to guess a predetermined price or prices for particular

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prizes. For example, if a price of an item is \$350, but the player guesses the price to be \$530, then the player loses. However, if the player guesses the correct price, \$350, the player wins. Therefore, the order in which a player selects digits to guess the price of a prize is important to the outcome of the game. Therefore, The Price is Right games anticipate claim 1.

21. Applicant alleges claim 3 is allowable because the claim depends upon claim 1.

However, Applicant's arguments amount to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes them from the references.

22. Applicant alleges claims 6-11 are allowable because each claim depends upon claim 1.

However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

23. Regarding claim 12, applicant alleges, "Vasquez does not disclose, teach, or suggest, providing an award that having an amount that equals the number entered by the player in display 36." However, regarding claim 12, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an award that having an amount that equals the number entered by the player in display...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

24. Applicant alleges claims 13-29 are allowable because each claim depends upon claim 12.

However, Applicant's arguments amount to a general allegation that the claims define a

patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

25. Applicant alleges claims 23-28 are allowable because each claim depends upon claim 12. However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

26. Applicant alleges claim 29 is allowable because the claim depends upon claim 12. However, Applicant's arguments amount to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes them from the references.

27. Applicant alleges claim 30 is allowable "for reasons described above" regarding Vasquez and The Price is Right games. However, the examiner respectfully disagrees. Please see the argument provided above in item number 16.

28. Applicant alleges claims 31-41 are allowable because each claim depends upon claim 30. However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

29. Applicant alleges claims 38-41 are allowable because each claim depends upon claim 30. However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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30. Regarding claim 43, applicant alleges, "the awards themselves in Vasquez are not based on the order of numbers by the player in display 36". The examiner respectfully disagrees.

Please see the argument provided above in item number 16.

31. Applicant alleges claims 43-46 are allowable because each claim depends upon claim 42.

However, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

32. Applicant alleges claim 45 is allowable because the claim depends upon claim 42.

However, Applicant's arguments amount to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes them from the references.

33. Regarding claim 47, applicant alleges, "neither Vasquez nor The Price is Right games disclose a game in which the player picks selections and a processor associates numbers based on the picked selections by the player with the ones digit and the tens digit in an award provided to the player." However, the examiner respectfully disagrees. Please see the argument provided above in item number 16.

34. Regarding claim 48, applicant alleges, "neither Vasquez nor The Price is Right games disclose a game in which the player picks selections and a processor associates numbers based on the picked selections by the player with the ones digit, the tens digit, and the hundreds digit in an award provided to the player." However, the examiner respectfully disagrees. Please see the argument provided above in item number 16.

35. Regarding claim 49, applicant alleges, "neither Vasquez nor any of The Price is Right pricing games disclose a game in which the award is based on the selections associated with the digits selected by the player." However, the examiner respectfully disagrees. Please see the argument provided above in item number 16.

36. For the reasons discussed hereinabove, the examiner maintains the rejections as stated in Office Action, Paper No. 4.

Conclusion

37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE can be reached on (703) 308-1148. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej

June 24, 2003



MICHAEL O'NEILL
PRIMARY EXAMINER